

REMARKS/ARGUMENTS

The Pending Claims

Claims 195-207, 222-295, 297-309, 311, and 312 currently are pending and subject to examination.

Amendments to the Claims

Withdrawn claims 354-358 have been canceled herein without prejudice or disclaimer. Applicants reserve the right to pursue subject matter encompassed by all canceled claims in one or more divisional or continuation applications.

Summary of the Office Action

Claims 207, 231, 291-294, 297-300, 309, 311, and 312 have been indicated as allowable except for being dependent upon a rejected base claim.

Claims 195-203, 205, 206, 222, 223, 225-230, 232-240, 242-247, 249-255, 257-263, 265-269, 271, 273-282, 284-290, 295, and 301-308 have been rejected for obviousness-type double patenting as allegedly unpatentable over claims 1-29 and 49-57 of U.S. Patent 7,879,328.

Claims 195-206, 222-228, 236-252, 254-260, 269-290, and 301-308 have been provisionally rejected for obviousness-type double patenting as allegedly unpatentable over claims 1, 4-6, 9-12, and 21 of co-pending U.S. Patent Application No. 12/170,333. Claims 195-206, 222-295, and 297-308 have been provisionally rejected for obviousness-type double patenting as allegedly unpatentable over claims 18 and 19 of co-pending U.S. Patent Application No. 12/870,548; over claims 1-9, 11-13, and 15-19 of co-pending U.S. Patent Application No. 12/870,394; and over claims 1, 9, 10, 15, 16, and 19 of co-pending U.S. Patent Application No. 12/965,535. Claims 195-206, 222-295, and 297-308 have been provisionally rejected for obviousness-type double patenting as allegedly unpatentable over claims 4, 5, 14, 18-21, 24, 35-39, 41, 45-48, 51, and 52 of co-pending U.S. Patent Application No. 12/952,091 in view of U.S. Patent 5,589,499.

Reconsideration of these rejections in view of the remarks set forth herein is respectfully requested.

Discussion of the Obviousness-Type Double Patenting Rejections

All of the obviousness-type double patenting rejections are based on certain method claims of *later-filed* patent applications. In particular, the Office contends that some of the methods recited in the pending claims are not patentably distinct from some of the methods recited in the pending or patented claims of commonly owned, later-filed, patent applications.

Applicants respectfully respond to each of the obviousness-type double patenting rejections as discussed below.

A. Rejection Over U.S. Patent 7,879,328

Claims 195-203, 205, 206, 222, 223, 225-230, 232-240, 242-247, 249-255, 257-263, 265-269, 271, 273-282, 284-290, 295, and 301-308 have been rejected for obviousness-type double patenting as allegedly unpatentable over claims 1-29 and 49-57 of U.S. Patent 7,879,328. In particular, the Office contends that, although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to methods of antagonizing Neutrokin-alpha in an animal having systemic lupus erythematosus or rheumatoid arthritis comprising administering an antibody that binds (i) amino acid residues 1-285 of SEQ ID NO: 2 of the instant application or (ii) amino acid residues 134-285 of SEQ ID NO: 2 of the instant application (Office Action dated March 2, 2011 at pages 4-5).

As acknowledged by the Office, the claims of the present application are genus claims in that they recite treating an autoimmune disease or disorder comprising administering an antagonist antibody that binds a protein comprising (i) amino acid residues 1-285 of SEQ ID NO: 2 or (ii) amino acid residues 134-285 of SEQ ID NO: 2, while the claims of the '328 patent are species claims because they recite a specific BLyS antibody to be administered (Office Action dated March 2, 2011 at page 7). In support of the obviousness-type double patenting rejection, the Office used a "one way" analysis, stating that, "[u]nless the record clearly shows administrative delay by the Office and that applicant could not have avoided filing separate applications, the examiner may use the one-way obviousness determination

and shift the burden to applicant to show why a two-way obviousness determination is required” (Office Action dated March 2, 2011 at page 8).

Solely to advance prosecution and not in acquiescence of the rejection, Applicants submit herewith a Terminal Disclaimer over U.S. Patent No. 7,879,328, thereby rendering this rejection moot.

B. Rejection Over U.S. Patent Application No. 12/170,333

Claims 195-206, 222-228, 236-252, 254-260, 269-290, and 301-308 have been provisionally rejected for obviousness-type double patenting as allegedly unpatentable over claims 1, 4-6, 9-12, and 21 of co-pending U.S. Patent Application No. 12/170,333.

The obviousness-type double patenting rejection with respect to the ‘333 application is provisional because the ‘333 application has not yet issued as a patent. As stated in M.P.E.P. § 804 I.B.1., “[i]f a ‘provisional’ nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer.” The present application has a filing date of June 8, 2000, whereas the ‘333 application has a filing date of July 9, 2008. In addition, the ‘333 application was rejected for obviousness-type double patenting over the present application, and a terminal disclaimer was filed with respect to the ‘333 application over the present application on August 30, 2010. Thus, the present application should be passed to issuance without the need to further address the provisional obviousness-type double patenting rejection.

In view of the foregoing, and the fact that the rejection is provisional in nature, Applicants respectfully submit that the obviousness-type double patenting rejection based on the ‘333 application should be withdrawn.

C. Rejection Over U.S. Patent Application Nos. 12/870,548, 12/870,394, and 12/965,535

Claims 195-206, 222-295, and 297-308 have been provisionally rejected for obviousness-type double patenting as allegedly unpatentable over claims 18 and 19 of co-

pending U.S. Patent Application No. 12/870,548; over claims 1-9, 11-13, and 15-19 of co-pending U.S. Patent Application No. 12/870,394; and over claims 1, 9, 10, 15, 16, and 19 of co-pending U.S. Patent Application No. 12/965,535.

The obviousness-type double patenting rejection with respect to the '548, '394, and '535 applications is provisional because the '548, '394, and '535 applications have not yet issued as patents. As stated in M.P.E.P. § 804 I.B.1., "[i]f a 'provisional' nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer." The present application has a filing date of June 8, 2000, whereas the '548 and '394 applications have a filing date of August 27, 2010 and the '535 application has a filing date of December 10, 2010. Thus, the present application should be passed to issuance without the need to further address the provisional obviousness-type double patenting rejection.

In view of the foregoing, and the fact that the rejection is provisional in nature, Applicants respectfully submit that the obviousness-type double patenting rejection based on the '548, '394, and '535 applications should be withdrawn.

D. Rejection Over U.S. Patent Application No. 12/952,091

Claims 195-206, 222-295, and 297-308 have been provisionally rejected for obviousness-type double patenting as allegedly unpatentable over claims 4, 5, 14, 18-21, 24, 35-39, 41, 45-48, 51, and 52 of co-pending U.S. Patent Application No. 12/952,091 in view of U.S. Patent 5,589,499.

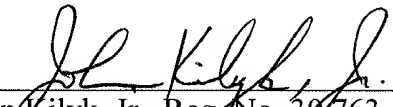
The obviousness-type double patenting rejection with respect to the '091 application is provisional because the '091 application has not yet issued as a patent. As stated in M.P.E.P. § 804 I.B.1., "[i]f a 'provisional' nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer." The present application has a filing date of June 8, 2000,

whereas the '091 application has a filing date of November 22, 2010. Thus, the present application should be passed to issuance without the need to further address the provisional obviousness-type double patenting rejection. In view of the foregoing, and the fact that the rejection is provisional in nature, Applicants respectfully submit that the obviousness-type double patenting rejection based on the '091 application should be withdrawn.

Conclusion

Applicants respectfully submit that the patent application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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